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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

In re Application of:

Appeal No. 2005-0046

CHUN-GEUN CHOI *et al.*

Serial No.: 09/531,005

Examiner: JOSEPH, THOMAS J.

Filed: 20 March 2000

Art Unit: 2174

For: VIDEO DISPLAY APPARATUS HAVING HOTKEY FUNCTIONS AND A  
METHOD THEREFOR

**REQUEST FOR CLARIFICATION OF DECISION ON APPEAL**

Paper No. 25

Attn: Board of Patent Appeals & Interferences

Commissioner for Patents

P.O.Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. §41.52, Appellants respectfully request a rehearing on the disposition of Appellant's appeal that was set forth in the Decision on Appeal mailed on March 24, 2005 in this application.

Folio: P56011  
Date: 5/24/05  
I.D.: REB/kf

**STATEMENT OF FACTS**

1. In a final Office action, Paper No. 5 issued on the 29<sup>th</sup> of April 2003, raised a single issue, namely the rejection of all pending claims, that is, claims 1 through 10, as rendered obvious, and unpatentable, under 35 U.S.C. §103(a) over the Examiner's proposed combination of Kurtenback *et al.*, U.S. Patent № 6.414.700 modified according to Foster U.S. Patent № 6.211.870.
2. No other rejections of any claims, nor any objection to either the claims, specification or drawings were presented in Paper No. 5.
3. Appellant filed an *Amendment After Final* on or about the 22<sup>rd</sup> of April 2003, proposing amendments of claims 1, 2, 4 and 8 through 10.
4. An *Advisory Action*, Paper No. 7 dated on the 6<sup>th</sup> of May 2003, refused entry of Appellant's proposed amendments of claims 1, 2, 4 and 8 through 10.
5. Appellant filed a second *Amendment After Final* on or about the 29<sup>th</sup> of May 2003, proposing amendments of claims 1, 2, 4 and 8 through 10.
6. An *Advisory Action*, Paper No. 10 dated on the 20<sup>th</sup> of June 2003, refused entry of Appellant's proposed amendments of claims 1, 2, 4 and 8 through 10.
7. Appellant filed a *Petition Under 37 CFR §1.181* on or about the 19<sup>th</sup> of August 2003, requesting, *inter alia*, entry of the second *Amendment After Final* on or about the 29<sup>th</sup> of May 2003.
8. Applicant timely filed an *Appeal Brief* on or about the 28<sup>th</sup> of August 2003, together with

- the requisite fee incurred under what is now 37 CFR §41.20(b)(2).
9. Appellant received a telephone advisory from the Examiner on Friday, the 26<sup>th</sup> of September 2003, ostensibly in response to Appellant's *Petition Under 37 CFR §1.181* on or about the 19<sup>th</sup> of August 2003, requesting entry of the second *Amendment After Final*; in the telephone advisory the Examiner stated that the amendments set forth in Appellants' *Second Amendment After Final* on the 29<sup>th</sup> of May 2003 would be entered.
  10. In response to the telephone advisory from the Examiner, and a subsequent telephone discussion with the Examiner on or about the 10<sup>th</sup> of October 2003, Appellant filed a *Substitute Appeal Brief* on or about the 10<sup>th</sup> of October 2003.
  11. The *Examiner's Answer* dated on the 3<sup>rd</sup> of November 2003, expressly stated that the Status of Amendments section of the *Appeal Brief* and the list of ClaimsAppealed were correct (see paragraphs (4) and (8) of the Answer); this confirmed that the *Second Amendment After Final* had been entered, and that the sole issue on appeal was the rejection which the Board of Appeals did in fact address, namely the rejection of claims 1 through 10 under 35 U.S.C. §103(a).
  12. Paragraph (6) on page 2 of the *Examiner's Answer* mailed on the 3<sup>rd</sup> of November 2003 stated that “[t]he appellant's statement of the issue in the brief is correct” (quoting from paragraph (6) on page 2 of the Answer).
  13. The *Substitute Appeal Brief* filed on the 10<sup>th</sup> of October 2003, indicated that the sole issue forestalling passage of this application to issue was the single issue before the Board of Appeals which was presented to the Board, and was duly decided by the Board,

was whether claims 1 thru 10 were improperly rejected under 35 U.S.C. §103(a) as rendered obvious, and thus unpatentable over the Examiner's proposed combination of Kurtenbach *et al.*, U.S. Patent No. 6,414,700 and Foster, U.S. Patent No. 6,211,870.

14. The first page of the Decision on Appeal states that "We affirm-in-part", while the last page of the *Decision on Appeal* states "AFFIRMED-IN-PART".
15. The claims considered by the Board of Appeals in the above-captioned appeal, and the claims discussed by the Board in the *Decision on Appeal*:
  - are the same claims that were belatedly entered by the Examiner prior to the filing of Appellant's *Substitute Appeal Brief* on or about the 10<sup>th</sup> of October 2003, and
  - are the same claims that were subsequently addressed by the Examiner in the *Examiner's Answer* dated on the 3<sup>rd</sup> of November 2003.
16. Appellants' undersigned attorney timely filed a request for clarification on the 8<sup>th</sup> of April 2005.

**POINTS BELIEVED TO HAVE BEEN MISAPPREHENDED OR OVERLOOKED**

Recognizing that there are no other issues pendent in either the above-captioned Appeal or in the above-captioned application, before either the Board of Appeals, before the Examiner, before the Special Program Examiners, before the Office of Petitions or before the Office of Legal Patent Administration, Appellant's undersigned attorney suggests that THE Board has misapprehended or overlooked one, or possibly more of the foregoing facts and the resolution prior to this appeal, of all issues, objections and other matters except the sole obviousness rejection decided by the Board, that the phrase "AFFIRMED-IN-PART" is a typographic error, and that the phrase "Reversed" should be substituted therefore.

As stated above, clarification is requested about the *Decision on Appeal* mailed on March 24, 2005 in this application.

Specifically, the first page of the *Decision on Appeal* states that "We affirm-in-part" (quoting from page 1 of the *Decision on Appeal*). Similarly, the signature of the page of the Decision on Appeal states "AFFIRMED-IN-PART" (quoting from page 13 of the *Decision on Appeal*).

The "CONCLUSION" of the *Decision on Appeal* stated:

"In summary, the rejection of claims 1-10 under § 103(a) is reversed" (quoting from page 12 of the *Decision on Appeal*).

This statement is consistent with the following further statements:

- page 10, last three lines of the *Decision on Appeal*: “we reverse the obviousness rejection of claim 1; of claims 2-4, which depend therefrom; of claim 8; and of claims 9 and 10, which depend therefrom”; and
- page 12 of the *Decision on Appeal*: “we reverse the rejection of claim 5; of claim 6, which depends from claim 5; and of claim 7”.

As stated in section VI on page 6 of the *Substitute Appeal Brief* filed on the 9<sup>th</sup> of October 2003, the sole issue forestalling passage of this application to issue was the single issue before the Board of Appeals which was presented, and decided, in this Appeal, namely whether claims 1 thru 10 were improperly rejected under 35 U.S.C. §103(a) for alleged unpatentability over the Examiner’s proposed combination of Kurtenbach *et al.*, U.S. Patent No. 6,414,700 and Foster, U.S. Patent No. 6,211,870.

In paragraph (6) on page 2 of the *Examiner’s Answer* mailed on November 3, 2003, the Examiner stated that “[t]he appellant’s statement of the issue in the brief is correct” (quoting from paragraph (6) on page 2 of the Answer).

It may be noted that, although the *Substitute Appeal Brief* contained a section (on pages 8-12) entitled “Petition for Entry of Second Amendment After Final”, both page 1 of the *Substitute Appeal Brief* and Section IV (Status of Amendments) on pages 2-3 thereof state that the Examiner had indicated, in a telephone conversation on 26 September 2003, that the *Second Amendment After Final* would be entered. Accordingly, the claims included with the *Substitute Appeal Brief* were the claims as amended in the *Second Amendment After Final*.

It may also be noted that the Examiner, in his Answer of the 3<sup>rd</sup> of November 2003, acknowledged that the Status of Amendments section of the Appeal Brief and the list of ClaimsAppealed were correct (*see* paragraphs (4) and (8) of the Answer), thus confirming that the Second Amendment After Final has been entered, and that the sole issue on appeal was the rejection under 35 U.S.C. §103(a).

Therefore, in view of the *Decision on Appeal* reversing the sole extant rejection, namely the Examiner's rejection of claims 1 thru 10 under 35 U.S.C. §103(a), it is respectfully submitted that pages 1 and 13 of the *Decision on Appeal* should have indicated that the final rejection of the claims was "Reversed".

Therefore, clarification is requested to explain precisely what portion of the final Office action was affirmed by the Board when the *Decision on Appeal* stated "Affirm-in-Part." Alternatively, the Board is respectfully requested to state that the Board has not sustained the sole rejection presented in the final Office action.

If there are any questions relative to this matter, the Clerk of the Board of Patent Appeals and Interferences is invited to telephone the undersigned attorney at the below-listed local telephone number.

RELIEF REQUESTED

The Board of Appeals and Interferences is therefore respectfully requested to:

- A. Amend the Decision on Appeal to state "REVERSED"; and
- B. Grant Applicant such other and further relief as justice may require.

Respectfully submitted,



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